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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/784,911

Filing Date: February 23, 2004

Appellant(s): XU ET AL.

Kelly K. Kordzik
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/07/2007 and 11/07/2008 appealing from the Office action mailed 09/20/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief as filed on 11/07/2008 is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are that the following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner:

WITHDRAWN REJECTIONS

The rejections of Claims 1-5, 7 and 9-19 under 35 U.S.C. §102(b) as anticipated by, or in the alternative, 35 U.S.C. 103(a) as being unpatentable over Pachl et al. (U.S. Patent No. 6,174.932)

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,149,592	WOJNAROWICZ	9-1992
6,060,530	CHAOUK ET AL.	10-2000
6,015,609	CHAOUK ET AL.	1-2000
6,160,030	CHAOUK ET AL.	12-2000
6,225,367	CHAOUK ET AL.	5-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5, 7 and 9-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Wojnarowicz (USPN 5,149,592).

In col. 1, lines 52-64, col. 2, lines 1-33, and col. 4, lines 1-4 and claims 3 and 8-10, Wojnarowicz teach an uncured curable composition comprising an monofunctional acrylate monomer, a fluorinated surfactant and a photoinitiator.

While the prior art may not expressly teach the disclosed properties of the claimed curable (liquid state) composition, such as overall viscosity, or the properties of a cured final product (solid state) prepared from the claimed uncured composition, it is reasonable that the composition of the prior art would possess the presently claimed properties since the composition is essentially the same as the claimed composition and the USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the sort. In any event, an otherwise old composition is

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not patentable regardless of any new or unexpected properties or applications. In re Fitzgerald et al, 619 F.2d 67,205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art.

Claims 1-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Chaouk et al. (USPN 6,060,530, 6,015,609, 6,160,030 or 6,225,367).

Chaouk et al. [(col. 8, lines 55-59, col. 10, lines 1-4 and col. 13, lines 26-29 in '530), (col. 9, lines 10-14, col. 10, lines 54-55 and col. 14, lines 34-37 in '609), (col. 10, lines 60-64 and col. 13, lines 21-22 in '030) and (col. 13, lines 10-13, col. 17, lines 2-33 and the examples in '367)] teach curable compositions comprising an acrylate monomer, a fluorinated surfactant and a photoinitiator.

While the prior art may not expressly teach the disclosed properties of the claimed composition and the resulting cured product, it is reasonable that the compositions of the prior art would possess the presently claimed properties since the composition are essentially the same as the claimed composition and the USPTO does not have at its disposal the tools or facilities deemed necessary to make physical

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determinations of the sort. In any event, an otherwise old composition is not patentable regardless of any new or unexpected properties or applications. *In re Fitzgerald et al*, 619 F.2d 67,205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art.

(10) Response to Argument

A. Pachl et al.

As these rejections have been withdrawn, the arguments against Pachl et al. are moot.

B. Wojnarowicz

Regarding Wojnarowicz, appellant argues that there is no basis supporting the conclusion that the compositions disclosed in Wojnarowicz possessed the properties required by the claims,. The basis provide by the Examiner for these rejections is the composition taught in Wojnarowicz, which is still essentially the same as appellant's claimed composition, including all of its recited components.

Regarding the argument that "the compositions disclosed in Wojnarowicz are not 'essentially the same as the claimed composition'" and that they are "chemically distinct

material from those disclosed in the present application”, appellant is reminded that the rejections over Wojnarowicz are of the material composition that is actually being claimed, regardless of any other unclaimed limitations that may be otherwise disclosed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding the argument that “Claim 1 and its dependent claims are not required to include at least one ... aliphatic urethane diacrylate normally provided as an oligomer”, appellant appears to be misstating the scope of their claims. Claim 1 (and its dependent claims) recites a composition “comprising” the surfactant, monomer and initiator. The “comprising” language encompasses any and everything that could conceivably be contained in the composition, and does not and would not exclude an aliphatic urethane diacrylate, particularly when in ¶ 30 of the present specification, appellant states that “To build up the strength of the polymerized material based on non-polar monomers, one may compromise and add higher viscosity components” (such as the aliphatic urethane diacrylate).

In any regard, it is well settled that the transitional term “comprising” **is** inclusive or open-ended and does not exclude additional, unrecited elements or method steps [See *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004)] and “comprising” leaves “the claim open for the inclusion of unspecified

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ingredients **even in major amounts**" In Gillette Co. v. Energizer Holdings Inc., 405 F.3d 1367, 1371-73, 74 USPQ2d 1586, 1589-91 (Fed. Cir. 2005). See MPEP, 2111.03

Thus, the composition recited in Wojnarowicz is still essentially the same compositions and would be expected to possess the presently claimed properties.

Regarding the argument that, in Wojnarowicz, some "components of the compositions disclosed therein have much greater viscosities that are well beyond this limit" of 100 centipoises", firstly, the "lower than about 100 centipoises" limit is not in reference to each component of the present composition, but to the composition as a whole. Thus, it is unclear "beyond" what limit appellant is referring to, as there is no such limit for each individual component in the composition.

Secondly, as stated above, ¶ 30 in appellant's specification makes a specific provision for "higher viscosity components" to be included in the present composition and they would not be excluded with the "comprising" language of the claims.

Thirdly, appellant makes no particular temperature requirement for the measurement of the viscosity of the claimed composition. Thus, at a given temperature, the prior art compositions would meet this viscosity requirement anyway.

Regarding the except from Wojnarowicz recited bridging pages 18 and 19 of the Appeal Brief, the monofunctional acrylates, having the viscosities from 20-50 cps, meet the requirements for appellant's "polymerizable component", and as demonstrated above, the aliphatic urethane acrylate monomers, which may or may not be in the form

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of oligomers, are not excluded from the present claims. Appellant is reminded that “comprising” leaves “the claim open for the inclusion of unspecified ingredients **even in major amounts**” In Gillette Co. v. Energizer Holdings Inc., 405 F.3d 1367, 1371-73, 74 USPQ2d 1586, 1589-91 (Fed. Cir. 2005). See MPEP, 2111.03

Regarding the presence of higher viscosity components in the composition, again, appellant is referred to their ¶ 30, where appellant discloses that the composition may comprise such strength building, (higher molecule weight) “higher viscosity components” in the present composition.

As the Examiner has provided the bases for the rejection of the claims over Wojnarowicz, based on appellant’s actual claim language and the teachings of the same composition in the prior art, the burden is shifted to appellant to demonstrate that the claimed properties were not present in the applied prior art composition, and that additional, the claimed properties were in fact present in the composition as claimed. Appellant failed to provide such a demonstration and, thus, the rejections were maintained.

Regarding the “obviousness arguments” and the argument that there is no suggestion or motivation to modify Wojnarowicz to make the claimed invention, as stated above, all of the components of the claimed composition are taught by Wojnarowicz. There is no need to modify the teachings in Wojnarowicz since

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Wojnarowicz teaches all the component required in appellant's claimed uncured (liquid state) composition in their uncured (liquid) composition.

Regarding the recited properties, as stated above, the viscosity recited in the claims as argued by appellant is not limiting in the way argued by appellant. As, appellant makes no particular temperature requirement for the measurement of the viscosity of the claimed composition, at the appropriate temperature, the prior art compositions would meet this viscosity requirement anyway.

In any regard, as the prior art composition is essentially the same as the claimed composition, it remains reasonable that the prior art composition would meet any property requirements of said claimed composition. The USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the sort. In any event, an otherwise old composition is not patentable regardless of any new or unexpected properties or applications. *In re Fitzgerald et al*, 619 F.2d 67,205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art.

Regarding dependent claims 2-5, 7 and 9-19, appellant presents and repeats arguments that center on their belief that the requirements for the rejection of the independent claim (claim 1) had not been met by Wojnarowicz, and thus, the rejection of the dependent claims would also not be met. This argument is not persuasive as the requirement for rejection of said independent claim, as demonstrated above, have been met. The specific limitations of claims 2-5, 7 and 9-19 are also met as taught in the portions of Wojnarowicz cited above. (see In col. 1, lines 52-64, col. 2, lines 1-33, and col. 4, lines 1-4 and claims 3 and 8-10).

Claims 6 and 8 were not rejected over Wojnarowicz.

C. The Chaouk patents

Regarding the four Chaouk patents, appellant argues that the “Examiner failed to provide basis of fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of”. In this case, the “basis of fact” in determination that the Chaouk patents would possess the physical properties recited in the claims is the fact that all the components recited in appellant’s claimed composition are taught in the applied composition of the Chaouk patents. The two compositions are essentially the same, so it would be expected that the properties for the two would be that same, absent any unexpected showing by appellant.

Appellant also argues that the compositions disclosed in the Chaouk patents “are chemically distinct material from those disclosed in the present application” because the Chaouk patents require at least one macromonomer having at least one perfluoropolyether unit and the “composition of Claim 1 is not required to include at least one perfluoropolyether unit.”

Again, appellant appears to be misinterpreting the scope of the claims. No where in the claims are such a macromonomer having at least one perfluoropolyether unit excluded from the composition. Appellant is again reminded that the “comprising” language used in the present claims leaves “the claim[s] open for the inclusion of unspecified ingredients **even in major amounts**” In Gillette Co. v. Energizer Holdings Inc., 405 F.3d 1367, 1371-73, 74 USPQ2d 1586, 1589-91 (Fed. Cir. 2005). See MPEP, 2111.03

Appellant is also remained that, in their specification (¶ 30), inclusion of such larger polymerizable (macromonomer) components (higher viscosity components) is discloses as being within the scope of appellant’s invention.

Thus, the compositions of the prior art are still essentially the same as the claimed composition. Even if the macromonomer were included in the composition of the Chaouk patents, it would not exclude these prior art compositions from the composition recited in the present claims.

In response to appellant’s argument that the present composition is intended to be used in imprint lithography and that the prior art intend to use their compositions in

forming porous polymer product, a recitation of the intended use of the claimed composition must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Regarding the argument that the final products prepared from the prior art would have a lower mechanical modulus than the final product prepared from the presently claimed composition, appellant is reminded that the present claims are not to the final product (cured products from the claimed composition). Even though properties of the intended final product are recited in the present claims, the claims are to the uncured composition.

In any regard, as the uncured compositions taught in the prior art are essentially the same as the claim uncured composition, absent any demonstration of unexpected evidence to the contrary, it would be expected that any properties derived there from would also apply to said prior art compositions. As the basis of fact has been presented by the Examiner with regard to the teaching of the same composition in the prior art, the burden was on appellant to present a demonstration of unexpected results/evidence. As appellant has still failed to meet this burden, the rejections are maintained.

In any regard, regarding the properties recited in the claims, as the prior art composition is essentially the same as the claimed composition, it remains reasonable that the prior art composition would meet any property requirements of said claimed composition. The USPTO does not have at its disposal the tools or facilities deemed

necessary to make physical determinations of the sort. In any event, an otherwise old composition is not patentable regardless of any new or unexpected properties or applications. *In re Fitzgerald et al*, 619 F.2d 67,205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Further, the viscosity recited in the claims as argued by appellant is not limiting in the way argued by appellant. As, appellant makes no particular temperature requirement for the measurement of the viscosity of the claimed composition, at the appropriate temperature, the prior art compositions would meet this viscosity requirement anyway.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art. Appellant has not presented any evidence demonstrating Regards,

Regarding the “Obviousness” arguments and the argument that “there is no suggestion or motivation to modify the Chaouk patents to make the claimed invention”, there is no need to modify the teachings in the Chaouk patents as they already teach all the component required in appellant’s claimed uncured (liquid state) composition in their uncured (liquid) composition.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art. Appellant has not presented any evidence demonstrating otherwise.

Regarding dependent claims 2-19, appellant presents and repeats arguments that center on their belief that the requirements for the rejection of the independent claim (claim 1) had not been met by the Chaouk patents, and thus, the rejection of the dependent claims would also not be met.

This argument is not persuasive as the requirement for rejection of said independent claim, as demonstrated above, have been met by the Chaouk patents. The specific limitations of claims 2-19 are also met as taught in the portions of the Chaouk patents cited above. See col. 8, lines 55-59, col. 10, lines 1-4 and col. 13, lines 26-29 in 6,060,530; col. 9, lines 10-14, col. 10, lines 54-55 and col. 14, lines 34-37 in 6,015,609; col. 10, lines 60-64 and col. 13, lines 21-22 in 6,160,030; and col. 13, lines 10-13, col. 17, lines 2-33 and the examples in 6,225,367.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

KCE

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